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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,811	12/02/2003	Francis Emmerson	042933/308284	4120

826 7590 08/16/2006

ALSTON & BIRD LLP  
BANK OF AMERICA PLAZA  
101 SOUTH TRYON STREET, SUITE 4000  
CHARLOTTE, NC 28280-4000

EXAMINER

MEHRPOUR, NAGHMEH

ART UNIT PAPER NUMBER

2617

DATE MAILED: 08/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/726,811

Applicant(s)

EMMERSON ET AL.

Examiner

Naghmeh Mehrpour

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 10 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. **Claims 1-16**, are rejected under 35 U.S.C. 102(e) as being anticipated by Maxwell (US Publication 20040148229 A1).

Regarding claims 1, 8-12, Maxwell teaches a mobile service system/method comprising a wireless client for a user and a remote service provider unit for providing content to the client (0164-0165), wherein the service provider unit comprises:

a memory for storing an application usable by the client both off-line and on-line; a port for receiving a request for the application from the client and for sending the application to the client (0038);

a processor for providing on-line use of the application for the client (0170);

a monitor for monitoring the on-line use of the application (0039);

a controller configured to control the processor to provide the on-line use of the application dependent on the monitoring (0052); and Maxwell inherently teaches the client comprising:

a port for communicating with the service provider unit, configured to send the request to the service provider unit and to receive the application from the service provider unit (0200);

a processor for off-line running the application whenever desired by the user and for on-line running the application when desired by the user if allowed by the controller (0040, 0050, 0057, 0200).

Regarding claim 2, Maxwell teaches a system according to claim 1, wherein the application is a game application (0075-0076).

Regarding claim 3, Maxwell teaches a system according to claim 1, wherein the monitor has been configured to keep account of available on-line use of the application and to decrement the available on-line use according to predetermined reduction criterion (0070).

Regarding claim 4, Maxwell teaches a system according to claim 1, further comprising a charging unit configured to collect a monetary charge for the sending of the application and for providing a certain amount of on-line use. (0074)

Regarding claim 5, Maxwell teaches a system according to claim 1, wherein the memory comprises a plurality of applications amongst which the client may select an application to be downloaded (0043, 0177).

Regarding claim 6, Maxwell teaches a system according to claim 1, further comprising means for informing the user when the amount of available on-line use is falling below a certain threshold (0175).

Regarding claim 7, Maxwell teaches a system according to claim 1, wherein the service provider unit further comprises means for determining a payment of a supplementary charge and increasing by a corresponding amount the available on-line use (0063).

Regarding claims 13-16, Maxwell teaches a computer program product comprising means for causing a network entity to provide content to a wireless client, comprising:

- computer executable program code configured to enable the network entity to store an application usable by the client both off-line and on-line (0171-0176);

- computer executable program code configured to enable the network entity to receive a request for the application from the client and for sending the application to the client (0183);

- computer executable program code configured to enable the network entity to provide on-line use of the application for the client (0183-188);

- computer executable program code configured to enable the network entity to monitor on-line use of the application (0168-0171); and

- computer executable program code configured to enable the network entity to control the providing of the on-line use of the application dependent on the monitoring of the on-line use of the application (0168-0173).

### ***Response to Arguments***

3. Applicant's arguments filed 2/10/06 have been fully considered but they are not persuasive.

In response to applicant's argument that the Maxwell fails to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the automatic tracking device and name changes can not be considered monitoring the on-line use of the features of present applications or controller) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that the Maxwell fails to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the controller of the Maxwell can not be consider the controller of the present application) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### **Conclusion**

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**5. Any responses to this action should be mailed to:**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naghmeh Mehrpour whose telephone number is 571-272-7913. The examiner can normally be reached on 8:00- 6:00.

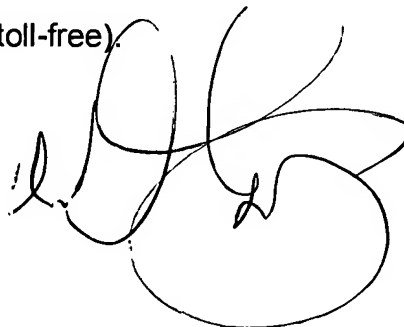
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick Corsaro be reached (571) 272-7876.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NM

August 9, 2006

A handwritten signature in black ink, appearing to be 'NM', located at the bottom right of the page.